

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WEI-MING LEE,
DAVID S. KUO, and JING GUI

Appeal 2008-0088
Application 10/662,426
Technology Center 1700

Decided: October 29, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and
CHARLES F. WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1, 2, 4 through 10, and 20 in the Office Action mailed April 21, 2006. Subsequently, Appellants canceled claim 20, leaving claims 1, 2, 4 through 10 for our consideration. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

We affirm the decision of the Primary Examiner.

Claim 1 illustrates Appellants' invention of a cleaning apparatus comprising a burnishing object, and is representative of the claims on appeal:

1. A cleaning apparatus comprising a burnishing object positioned over or under a disk and extending adjacent a surface of the disk at an angle that is offset from a line passing through the center of the disk, and a device that (a) rotates the burnishing object to change the offset angle of the burnishing object and (b) translates the burnishing object relative to the disk to advance a position of a contact of the burnishing object across the surface of the disk,

wherein the device changes the offset angle of the burnishing object and translates the burnishing object while cleaning the disk.

The Examiner relies upon the evidence in this reference (Answer 2):

Tateyama 5,375,291 Dec. 27, 1994

Appellants request review of the following grounds of rejection advanced on appeal (Br. 7):

Claims 1, 2, and 4 through 8 under 35 U.S.C. § 102(b) as anticipated by Tateyama (Answer 3); and

Claims 9 and 10 under 35 U.S.C. § 103(a) as unpatentable over Tateyama (*id.* 4).

Appellants argue claim 1 with respect to the first ground of rejection and argue the claims of the second ground as a group. Br. 10-11 and 11-12. Thus, we decide this appeal based on claims 1 and 10 as representative of the grounds of rejection and Appellants' groupings of claims. 37 C.F.R. § 41.37(c)(1)(vii) (2006).

The issues in this appeal are whether the Examiner has carried the burden of establishing a *prima facie* case in each of the grounds of rejection advanced on appeal.

The plain language of claim 1 specifies, with respect to Specification Fig. 2, a cleaning apparatus comprising any burnishing object 19 capable of being positioned over a disk to extend adjacent a surface of the disk at angle α that is offset from a line passing through the center of the disk, and a device that can (a) rotate burnishing object 19 to change the offset angle thereof, and (b) translate burnishing object 19 relative to the disk to advance a position of a center of contact of burnishing object 19 across the surface of the disk. The claimed cleaning apparatus works on the disk and thus, the disk forms no structural part of the cleaning apparatus. See, e.g., *In re Otto*, 312 F.2d 937, 939-40, 136 USPQ 458, 459-60 (CCPA 1963) ; *In re Rishoi*, 197 F.2d 342, 344-45, 94 USPQ 71, 72-73 (CCPA 1952); *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). The cleaning apparatus must be capable of assuming the positions relative to the disk and performing the functions as set forth in claim 1.

Appellants' principal contention involves the function of the "device" to "[translate] the burnishing object relative to the disk to advance a position of a contact of the burnishing object across the surface of the disk." Br. 10-11. We interpret this claim language in context to specify that the device must be capable of translating the burnishing object between any one point and any other point on the surface of the disk in advancing a position of contact with the surface of the disk, regardless of the course of the burnishing object between the two points. In this respect, we find no basis in the claim language or in the disclosure in the Specification to read the term "linearly" into the claim as a limitation on "to advance a position of a contact" with respect to the translational course between the two points as

disclosed in Specification ¶ 0030. *See, e.g., In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

We find Tateyama would have described to one skilled in this art two embodiments of a device for cleaning a disk illustrated in Figs. 1, 2, 8, and 9. The device has a burnishing object which is either brush material 42 wound around shaft 44 or disk brush 202 of the same material. Each of brushes 42 and 202 can be rotated in the direction θ by respective mechanisms 41 and 9, and are contacted with the top surface of the spinning disk. We find one skilled in this art would infer from the illustrated position of the respective mechanisms and the brushes in Figs. 1 and 8 that, during the cleaning operation, the brushes are positioned over the disk, extending adjacent a surface at an offset angle to the center line thereof, and can be rotated by the mechanisms to change the offset angle, thus translating the brushes by advancing the brushes from the first position of contact to a second position of contact. Tateyama, e.g., col. 2, ll. 4-5, col. 3, l. 62, to col. 4, l. 29, col. 5, ll. 23-40, col. 7, ll. 5-22, col. 8, ll. 10-28.

Accordingly, on this record, we agree with the Examiner that *prima facie*, as a matter of fact, Tateyama describes to one skilled in this art a cleaning device that meets each and every limitation of the claimed cleaning device encompassed by claim 1, arranged as required therein, as we interpreted this claim 1. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), and cases cited therein.

We are not persuaded otherwise by Appellants' contentions. We determined that there is no limitation on the course of translation of the burnishing object across the disk specified in claim 1. In this respect, Appellants argue that for this claim limitation to be read "on Tateyama, the

burnishing object . . . brush 42, must translate along one of the axes, for example the Y direction relative to the disk.” Br. 10-11. However, translation along an axis is “linear,” and such a limitation is not in claim 1.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of anticipation found in Tateyama with Appellants’ countervailing evidence of and argument for non-anticipation and conclude that the claimed invention encompassed by appealed claims 1, 2 and 4 through 8 would have been anticipated as a matter of fact under 35 U.S.C. § 102(b).

Turning to the ground of rejection of claim 10 under § 103(a) over Tateyama, we agree with the Examiner that exchanging wrapped brush 42 and disk brush 202 for a “pad” of the same material would have been an obvious modification to one of ordinary skill in the art. Answer 4-5. Indeed, we find one of ordinary skill in this art would have inferred from Tateyama Figs. 2 and 9 that the long strip of material forming wrapped brush 42 and the disk of material forming disk brush 202 are essentially pads. Thus, we find in Tateyama convincing evidence supporting the Examiner’s case that the claimed invention encompassed by claim 10 would have been prima facie obviousness to this person. *See, e.g., KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007) *quoting In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006) (“[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA

1969) (“Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness ‘from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.’”); *In re Siebentritt*, 372 F.2d 566, 567-68, 152 USPQ 618, 619 (CCPA 1967) (express suggestion to interchange methods which achieve the same or similar results is not necessary to establish obviousness). Appellants principally rely on the same arguments submitted with respect to claim 1 which we considered above. Br. 11-12.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in Tateyama with Appellants’ countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 9 and 10 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The Primary Examiner’s decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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